

U.S. Application No. 10/695,008, filed October 28, 2003
Attorney Docket No. 15128US02
Response dated October 2, 2008
In Response to Office Action mailed June 2, 2008

REMARKS

Claims 1-37 are pending. Claims 1-37 are rejected.

Rejection under 35 U.S.C. § 103

Claims 1-37 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2005/0010527 A1 (“Rarick”) in view of U.S. Patent Publication No. 2005/0015558 A1 (“Evans”) and further in view of U.S. Patent No. 7,284,133 (“Watanabe”). Applicants respectfully traverse the rejection for at least the reasons as set forth below.

I.

M.P.E.P. § 2142 states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”

It is respectfully submitted that, due to USPTO error, the initial burden of factually supporting the *prima facie* conclusion of obviousness is insufficient.

Evans has an actual filing date of July 21, 2004. The present application has an actual filing date of October 28, 2003. Therefore, the present application antedates the actual filing date of Evans. Accordingly, Evans is not prior art with respect to the present application.

The Office Action does not provide any additional facts with respect to Evans. It is noted that Evans is merely a continuation-in-part application. However, Evans can only benefit from an earlier effective filing date of any parent applications if the Office Action necessarily provides a **showing of support** that, for example, at least the alleged specified teachings in Evans are fully supported by the parent applications.

The Office Action does not make the **necessary showing of support** and completely ignores this aspect of proof in the *prima facie* case.

In accordance with M.P.E.P. § 2142, Applicants are “under no obligation to submit evidence of nonobviousness” since “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

Thus, without anything more, Evans cannot merely automatically benefit from the earlier effective filing date of the parent applications since Evans is a continuation-in-part application and not, for example, a continuation application or a divisional application, which presumably would not necessarily require such a showing.

Since the error is on the USPTO due to a lack of proof in presenting a *prima facie* case of obviousness, it is respectfully requested that the Examiner, in a subsequent **Non-Final Office Action**, discuss with particularity exactly where, in the parent applications, Evans can find support to benefit from an earlier effective filing date.

Since the Office Action does not make the **necessary showing of support** with respect to the parent application of Evans, the obviousness rejections based on the combination of Evans and other cited documents cannot be maintained.

II.

In addition, Applicants respectfully note that the Office Action at page 3 states that “Rarick is mute in teaching that the decryptor is adapted to: to add a first key to the bit-shuffled data”. The Office Action at page 3 continues “[f]or the above limitation, examiner relies upon the Evans reference. Evans teaches in paragraph 40 of a write mask memory system in which a key generator provides a key value is combined with a coded data block. The system taught by Evans is interpreted as being analogous to the adder that is claimed by applicant.”

However, Evans at paragraph [40] appears to teach away from the very reasoning that the Office Action provides for using the teachings of Evans in the obviousness rejection. Evans at paragraph [40] states:

A key generator that includes a plurality of decoders and binary propagation tree provides many **advantages over** a key generator having binary **adders**. A key generator including decoders and a binary propagation tree uses less or approximately the same circuit area, has less latency and allows for the use of standard hardware design tools.

Evans at paragraph [40] (bolded added).

Thus, the key generator of Evans which is cited by the Office Action at page 3 actually specifically and directly teaches away from the use of adders according to Evans at paragraph [40].

According to Evans, by avoiding adders, the key generator of Evans, for example, uses less circuit area, has less latency and allows for the use of standard hardware design tools. Apparently, according to Evans, it is disadvantageous to use adders.

Thus, it appears that citation to Evans, namely, Evans at paragraph [40] teaches away from the very reasoning provided by the Office Action at page 3 in using the teachings of Evans.

In addition, to the extent that it is applicable, it appears that Evans at paragraph [40], which is cited in the Office Action at page 3, appears to teach away from adders and thus appears to possibly teach away from the recited claim language. If so, then this would be an example of Evans teaching away from one or more elements recited in a claimed invention.

M.P.E.P. § 2145(X)(D)(1) states that “[a] prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness”

Since the citation to Evans, namely, Evans at paragraph [40] appears to not only teach away from the very reasoning provided by the Office Action at page 3 in using the teachings of Evans, but also possibly teaches away from one or more recited claim elements as discussed in the Office Action at page 3, the *prima facie* case of obviousness based on the combination of Evans and other cited documents cannot be maintained.

III.

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 1-37.

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Conclusion

Applicants do not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicants hereby rescind any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: October 2, 2008

Respectfully submitted,

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